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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,702	06/18/2001	Gilles Chriqui	Q64917	8603

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EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,702

Applicant(s)

CHRIQUI, GILLES

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-13 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment and 1.132 declaration filed 8/18/03.

Further, applicants' filing of the foreign priority document on 9/26/03 is noted.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001.

The rejection is adequately set forth in paragraph 14 of the office action mailed 10/8/02, Paper No. 2, and is incorporated here by reference.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001 as applied to claims 1-3, 5, and 8 above, and further in view of Coaker et al. (U.S. 5,036,121).

The rejection is adequately set forth in paragraph 15 of the office action mailed 10/8/02, Paper No. 2, and is incorporated here by reference.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,016,016 in view of EP 721001 as applied to claims 1-3, 5, and 8 above, and further in view of Schombourg et al. (U.S. 6,448,343).

The rejection is adequately set forth in paragraph 16 of the office action mailed 10/8/02, Paper No. 2, and is incorporated here by reference.

Response to Arguments

6. Applicants' arguments regarding Igarashi et al. (U.S. 5,149,732), Keogh et al. (U.S. 4,407,992), Nitta et al. (U.S. 6,075,086), and Abe et al. (U.S. 5,296,273) have been considered but they are moot in view of the discontinuation of these references against the present claims.

7. Applicants' arguments filed 8/18/03 have been fully considered but, with the exception of arguments relating to Igarashi et al., Keogh et al., Nitta et al., and Abe et al., they are not persuasive.

Specifically, applicants argue that:

(a) the combination of GB 2,016,016 in view of EP 721001 does not disclose ingredients in the recited proportions.

(b) The combination of GB 2,016,016 in view of EP 721001 does not disclose the recited order for preparing the composition.

With respect to argument (a), it is noted that GB 2,016,016 discloses composition comprising 10-50 parts chlorinated polyolefin (per 100 part vinyl acetate-ethylene copolymer)

and 70-300 mineral filler, which is treated with 1-4 parts silane coupling agent. Thus, for 100 parts chlorinated polyolefin, the composition would possess 140-600 parts mineral filler and 2-8 parts silane coupling agent, which overlaps the amounts in present claims 1 and 5. It is calculated that the ratio of filler to chlorinated polyolefin is 1.4-6, which clearly overlaps the ratio of present claim 8.

With respect to argument (b), it is agreed that neither GB 2,016,016 or EP 721001 disclose the recited order for preparing the composition which is why the references are no longer used to reject claim 9 (and all claims which depend on claim 9) which is drawn to method of preparing the composition.

However, claim 1 is drawn to a composition not a method of preparing a composition. Claim 1 requires basic mixture comprising chlorinated polyolefin, mineral filler, and treating agent for the mineral filler and aminosilane for curing the mixture. There is no requirement regarding how or in what order the ingredients are mixed. The claims only require aminosilane "suitable for" curing the chlorinated polyolefin. There is no requirement that the aminosilane actually reacts with the chlorinated polyolefin. Rather, claim 1 only requires composition comprising basic mixture and aminosilane.

Given that the combination of GB 2,016,016 in view of EP 721001 discloses composition comprising chlorinated polyolefin, mineral filler, treating agent for the mineral filler, and aminosilane, it is the examiner's position that the combination meets the requirements of claim 1.

Allowable Subject Matter

8. Claims 9-13 are allowable over the “closest” prior art GB 2,016,016 and Igarashi et al. (U.S. 5,149,732) given that there is no disclosure of method for preparing composition as required in the claims. There is no disclosure in either GB 2,016,016 or Igarashi et al. of mixing chlorinated polyolefin, filler, and treating agent first, followed by addition of aminosilane.

This is especially significant in light of applicants’ 1.132 declaration filed 8/18/03, which discloses the criticality regarding the presently claimed method and the recited order for mixing the ingredients. The declaration discloses that the order in which the presently claimed ingredients are mixed together is important because it allows the aminosilane to react directly with the chlorinated polyolefin without being deactivated by the filler so that the aminosilane is grafted to the chlorinated polyolefin without giving off hydrochloric acid. Further, the declaration discloses that the present method prevents frequent clogging of extruder, avoids potential curing during storage, and is inexpensive.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
11/7/03